REMARKS

Summary

This Amendment is responsive to the Office Action mailed on September 20, 2004. Claims 1-8 are amended herein. Claims 9 and 10 are new. Claims 1-10 are pending.

The Examiner has requested copies of the foreign patent documents which were apparently not received by the Examiner. Applicant submits that all foreign references were submitted with the Information Disclosure Statements filed in this application. However, as requested, copies of the references not received by the Examiner are re-submitted herewith, together with clean copies of Applicant's 1449 Forms for the Examiner to initial and return with the next Official Communication.

The Examiner has indicated that there is no Oath or Declaration associated with the application. Applicant respectfully submits that a Declaration was filed with Applicant's Missing Parts submission on February 1, 2001. A copy of the return receipt postcard bearing the Patent Office's receipt stamp and listing the Declaration as an enclosure is submitted herewith, together with a copy of the Declaration as filed.

The Examiner has rejected claims 1-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. patent no. 6,748,471 to Keeney. U.S. patent no. 6,748,471 is commonly owned by the assignee of the present invention, Electronics for Imaging, Inc. A Terminal Disclaimer is submitted herewith to overcome the double patenting rejection based on U.S. patent no. 6,748,471. Withdrawal of the double patenting rejection is respectfully requested.

The Examiner has also provisionally rejected claims 1-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable as being unpatentable over claims 1-90 of application no. 09/688,475, and claims 1-108 of application no. 09/688,457. These applications are also commonly owned by the assignee of the present invention. In the event that either or both of these applications issue before the present application, and the Examiner's provisional rejection is maintained, Applicant will submit a Terminal Disclaimer regarding such issued patent(s).

Claims 3 and 7 stand rejected under 35 U.S.C. § 112 as being indefinite. Claims 3 and 7

are amended herein to overcome the Examiner's rejection, withdrawal of which is respectfully requested.

Claims 1-8 stand rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Motegi (US 6,307,640) in view of Adamske (US 6,615,234).

Applicant respectfully traverses the foregoing rejections in view of the amended claims and the following comments.

Discussion of Amended Claims

The claims are amended to specify that the printer is separated from the spooling server by a gateway firewall, and that the spooling server sends the print job through the gateway firewall to the printer such that reconfiguration of the gateway firewall is not required (See, e.g., Applicant's specification, page 18, lines 2-4).

As discussed in Applicant's specification, specific holes in a firewall are typically created for each type of traffic that is allowed through the firewall in each direction. For example, most organizations create holes for email traffic into and out of their email server, as well as holes for web page client access from inside the firewall to web servers outside the firewall. Typically, such holes are created by firewall administrators each time a new type of traffic is required to pass through the firewall (see, e.g., Applicant's specification, page 4, line 3 through page 6, line 13).

By forwarding a print job in such a way that reconfiguration of the firewall to include a hole for the print job is not necessary, the present invention overcomes problems with prior art firewall systems which require intervention of a firewall administrator to open a specific hole for the print job traffic. The prior art does not provide the advantages of Applicant's claimed invention.

Claims 9 and 10 are new and depend from claims 1 and 5, respectively. New claims 9 and 10 specify that the polling request is _automatically forwarded_ to the spooling server from a printer polling device associated with the printer.

Discussion of Motegi and Adamske

Motegi discloses a computer-based network printing system. Two computer pairs (101 and 102, 103 and 104) are connected to network servers (105, 106). The network servers 105 and 106 are connected to a host computer 113, which controls the network. Two printer pairs (107 and 108, 109 and 110) are connected to print servers 111 and 112, which are in turn connected to the host computer 113 (Col. 2, lines 42-52).

In Motegi, four users A-D send print information to the host computer 113 via the network servers 105 and 106. The users have control over which of the four printers 107-110 are used for the print operation by entering a job number and/or password at the specific printer (Col. 2, lines 56-67).

Motegi does not disclose or remotely suggest the use of any type of gateway firewalls in the network. In particular, there is no mention of a firewall between the host computer 113 (which the Examiner has equated with Applicant's claimed spooling server) and the printers 107-110. Typically, with an arrangement such as that disclosed in Motegi, the computers 101-104, the network servers 105 and 106, the host computer 113, the printer servers 111 and 112, and the printers 107-110 would all be arranged within the same gateway firewall. Accordingly, with the system of Motegi, the problem of reconfiguring a firewall to print from computers 101-104 to printers 107-110 is never an issue.

Motegi does not disclose or suggest that a spooling server is separated from a printer by a gateway firewall, and that the spooling server forwards the print job through the gateway firewall to the printer such that reconfiguration of the gateway firewall is not required, as claimed by Applicant

Adamske does not cure the deficiencies of Motegi. Adamske discloses a system for network based document delivery. Figure 2 of Adamske relied on by the Examiner in rejecting claim 3 shows a client computer 11 connected to the document delivery system 20 via network 12 (e.g., the Internet). Document delivery system includes a web server 22, an application translation server 24, a centralized file server 26, a print manager server 28, and a database 29 (Col. 4, lines 40-48). User 10 can upload a document from client computer 11 to web server 22

using a standard browser. Web server 22 routes the document to the translation server 24 for conversion (Col. 5, lines 14-19). Print manager 28 retrieves the converted printable document and send it to the remote print spool server 30, which prints the document at printer 40 (Col. 7, lines 27-35).

Like Motegi, Adamske does not disclose or remotely suggest the use of gateway firewalls. The Examiner has apparently equated the print management server 28 with a gateway firewall (Office Action, page 6). Print management server 28 manages the remote print servers 30, including updating the database record to indicate the document has printed, and initiating a notification email to the user. Print manager 28 also determines the ID, and therefore the location, of the remote print server 30 (Col. 7, lines 57-65). Nowhere in Adamske is it suggested that print management server 28 acts as a firewall.

Further, Applicant's amended independent claims specify a firewall between the spooling server and the printer (i.e., between document delivery system 20 and the server 30/printer 40 of Adamske). In Adamske, there is no provision for a firewall between the document delivery system 20 and the server 30 or the printer 40. No intervening firewall is shown in the Figures of Adamske.

Adamske does not disclose or suggest that a spooling server is separated from a printer by a gateway firewall, and that the spooling server forwards the print job through the gateway firewall to the printer such that reconfiguration of the gateway firewall is not required, as claimed by Applicant.

Adamske, like Motegi, does not address the problems of forwarding print jobs form a spooling server to a printer that is within a gateway firewall that is solved by Applicant's claimed invention.

Accordingly, even if one skilled in the art would somehow be motivated to combine the disclosures of Motegi and Adamske as suggested by the Examiner, such a combination would not result in Applicant's claimed invention, since neither of these references discloses or suggests Applicant's claimed gateway firewall between the printer and the spooling server, or the forwarding of the print job through the gateway firewall such that reconfiguration of the gateway firewall is not required.

New claims 9 and 10 specify that the polling request is automatically forwarded to the spooling server from a printer polling device associated with the printer. In Motegi, <u>user interaction</u> (i.e., entry of a password and/or a job number) is required at the printer before a document can be sent to the printer. In contrast, with Applicants' claimed invention as set forth in new claims 9 and 10, <u>no user interaction at the printer end is required</u>, as the polling request is <u>automatically</u> forwarded from the printer polling device associated with the printer to the spooling server. In Adamske, the document is sent to network server 30 and printed at printer 40 as soon as it is converted into the appropriate format at document delivery server 20, without any type of communication from the printer end of the system to the network server 30 or the document delivery server 20.

Neither Motegi nor Adamske discloses or remotely suggests that a polling request is automatically forwarded to the spooling server from a printer polling device associated with the printer, as claimed by Applicant's in new claims 9 and 10.

Applicant respectfully submits that the present invention would not have been obvious to one skilled in the art in view of Motegi, taken alone or in combination with Adamske, or in view of any of the other references of record.
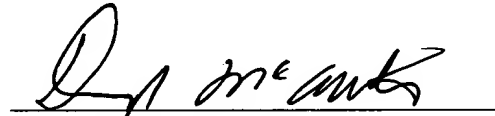
Withdrawal of the rejections under 35 U.S.C. § 103(a) is therefore respectfully requested.

Further remarks regarding the asserted relationship between Applicant's claims and the prior art are not deemed necessary, in view of the amended claims and the above discussion. Applicant's silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.

Conclusion

The Examiner is respectfully requested to reconsider this application, allow each of the presently pending claims, and to pass this application on to an early issue. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicant's undersigned attorney.

Respectfully submitted,

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ATTORNEY DOCKET NO.: MGI-179
Date: November 16, 2004